

REMARKS

Prior to this Amendment "D", claims 1 and 5 were pending in the subject application. In this Amendment "D", Applicant has canceled claims 1 and 5 and added new claims 8-11.

In the Office action, the Examiner has rejected claims 1 and 5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,720,515 to Renz et al (the "Renz Patent") in view of U.S. Patent No. 3,812,314 to Nonken (the "Nonken Patent"). Although claims 1 and 5 have been canceled, Applicant will discuss new independent claim 8 in light of the Renz Patent and the Nonken Patent.

The Renz Patent discloses a three-position vacuum interrupter having a metallic part 13 located toward the center thereof. The metallic part 13 is located between ceramic insulators 11, 12 and has a flange 15. The metallic part 13 forms a grounding contact of the vacuum interrupter. The Renz Patent does not disclose the vacuum interrupter as being used in gas insulated switch gear and does not disclose the flange 15 as being connected to any type of structure. The Examiner acknowledges that the Renz Patent does not disclose an enclosure, but cites the Nonken Patent as doing so. The Examiner finds that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to install the switchgear of Renz et al. into an enclosure, as suggested by Nonken". Continuing, the Examiner further finds that it would be obvious to "provide a seal between the extending board [flange 15] and a portion of the enclosure in order to seal the gas enclosure."

The Nonken Patent discloses a multi-terminal bushing 1' having a molded epoxy resin housing 1a' that encapsulates a pair of vacuum switches 4', 4''. Way below the vacuum switches 4', 4'', toward the bottom of the housing 1a', a steel flange 2' is partially molded into the housing 1a'. The steel flange 2' is welded to a steel tank 16 filled with an insulating gas, such as Freon. The vacuum switches 4', 4'' are not three-position switches and do not have a grounding contact.

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In order to use the vacuum interrupter of the Renz Patent with the steel tank 16 of the Nonken Patent as urged by the Examiner, the vacuum interrupter of the Renz Patent would have to be drastically modified. More specifically, the flange 15 (and, thus, the entire metallic part 13) of the Renz Patent would have to somehow be moved below the bottom ceramic insulator 12 so as to be located where the steel flange 2' of the Nonken Patent is located, i.e., below the vacuum interrupter. Such a drastic modification of the vacuum interrupter of the Renz Patent would require the invention of the Renz Patent to be discarded because the location of the metallic part 13 between the ceramic insulators 11, 12 is part of claim 1 of the Renz Patent. This cannot be considered obvious. As held in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In making its holding, the CCPA stated that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Based on the foregoing, Applicant submits that the Renz Patent and the Nonken Patent cannot be combined as the Examiner has done, and that new independent claim 8 and the claims depending therefrom are patentable over the Renz Patent and the Nonken Patent. Accordingly, Applicant submits that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any fees resulting from this communication, please charge same to our Deposit Account No. 050877.

Respectfully submitted,

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